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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,155	02/26/2004	Kenichirou Kurata	62807-168	9149

7590 03/26/2009  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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KARDOS, NEIL R

ART UNIT	PAPER NUMBER
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3623

MAIL DATE	DELIVERY MODE
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03/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,155	<b>Applicant(s)</b> KURATA ET AL.	
	<b>Examiner</b> Neil R. Kardos	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/26/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

This is a **NON-FINAL** Office Action on the merits in response to communications filed on February 26, 2004. Currently, claims 1-12 are pending.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 9: Claim 9 is directed toward a "personal digital assistant" comprising various "units." However, the claim does not positively recite any elements that necessarily constitute a system or apparatus, such as computer hardware. Rather, the claim could be directed to software. Software per se is not patentable under § 101; therefore, the claimed invention does not fall within a statutory class of patentable subject matter. *See* MPEP 2106.01.

For example, a "personal digital assistant" as well as the claimed "units" are not necessarily hardware components (i.e. they could be software given their broadest reasonable interpretation). The preamble of the claim recites a "center including servers connected to the personal digital assistants via a network." However, the preamble merely recites that the

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personal digital assistant is used in such a system. The personal digital assistant itself could still be software. Furthermore, the preamble is generally not afforded patentable weight when the body of the claim is capable of standing on its own. See MPEP 2111.02.

Claims 10-12: Dependent claims 10-12 are rejected for failing to remedy the deficiencies of the claims from which they depend.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segawa (US 2002/0032037) in view of Knight (US 6,859,807).**

Claim 1: Segawa discloses an information gathering system having terminals connected to a network and a center including servers connected to a network, for acquiring specific information from information input to the terminals (see figures 1, 11, and 12):

- wherein a keyword list is transmitted from the center to the terminals (see ¶¶ 33-37, disclosing extracting keywords from text data that has been converted from voice data; ¶¶ 74-75); and
- the center receives from each of the terminals a number of information matching or associated with at least one keyword in the keyword list and the keyword

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corresponding to the number of the information, the information being input to each terminal by users, thereby acquiring the specific information (see ¶¶ 36-37, disclosing analyzing statistical qualities of keywords; ¶¶ 74-75).

Segawa does not explicitly disclose determining the number of matching keywords.

However, Segawa suggests this limitation by disclosing statistical analysis of keywords. Knight discloses this limitation (see column 9: lines 35-37, disclosing returning a number of "hits" or matching records; column 20: lines 20-59, disclosing tabulating keywords in a message; column 5: lines 39-44, disclosing tabulating information from posting and query entries; column 6: lines 44-47, disclosing tabulating data pertaining to frequency of information category usage). Knight and Segawa are both related to searching messages for keywords. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the tabulation of keywords taught by Knight as one of the statistical measures taught by Segawa. One of ordinary skill in the art would have been motivated to do so for the benefit determining subjects that are of interest to the community (see Knight: column 20: lines 35-41).

Claim 2: Segawa discloses wherein the center receives information on characteristics of each of the users of the terminals together with the number and the corresponding keyword, obtained at said each of the terminals (see figure 6, disclosing transmitting user position information and ID number).

Claim 3: Segawa discloses wherein the center transmits to the terminals a period of acquiring the specific information by the center so as to cause the users to confirm the period

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(see ¶ 28, disclosing providing information to the terminals that has been accumulated for a period of time; ¶ 26, disclosing maintaining an electronic bulletin board for a certain period of time; ¶ 27).

Claim 4: Segawa discloses wherein the center classifies the specific information received from the terminals according to characteristics of the users (see figure 6, disclosing transmitting user position information and ID number) and the center transmits the information classified according to the characteristics of the users to the terminals when a part of the characteristics used for classification matches a part of characteristics of a specific user (see ¶ 13, disclosing that users in the same location can share information; ¶¶ 23, 29).

Claims 5 and 9: Claims 5 and 9 are substantially similar to claim 1 and are rejected under similar rationale. Claims 5 and 9 contain the additional limitation of specifying at least one or more keywords from the received keyword list in advance on the terminals. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to perform pre-processing rather than post-processing of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify keywords desired to be monitored in advance rather than after receiving the data. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by real-time monitoring.

Claims 6 and 10: Claims 6 and 10 are substantially similar to claim 2 and are rejected under similar rationale.

Claims 7 and 11: Claims 7 and 11 are substantially similar to claim 3 and are rejected under similar rationale.

Claim 8: Claim 8 is substantially similar to claim 4 and is rejected under similar rationale.

Claim 12: Segawa discloses wherein the information input to the personal assistant is voice data or text data (see ¶ 42).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Cooper, et al. "Building Searchable Collections of Enterprise Speech Data." Joint Conference on Digital Libraries 2001. pp. 226-234.
- Bowater et al (US 6,278,772), directed to voice recognition of telephone conversations, including keywords
- Kim et al (US 2002/0052925), directed to targeted advertising based on matching keywords
- Herz (US 7,483,871), directed to customized electronic newspapers and advertisements

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos  
Examiner  
Art Unit 3623

NRK  
3/23/09  
/Jonathan G. Sterrett/  
Primary Examiner, Art Unit 3623